

**Remarks:**

The applicants thank the Examiner for noting that claims 49-54 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 49 -54 have been so amended and allowance as to such claims is courteously solicited.

New claims 58-63 have been added to claim compositions containing bis-succinimides and aromatic imides of the structure disclosed at p. 9 of the present application. Such compositions are not obvious in view of the prior art.

Claims 55-57 have been canceled without prejudice.

Applicants traverse the rejection of claims 1-7, 19-32, 48 and 57 under 35 U.S.C. 102(a) over U.S. Patent No. 5,137,980 to DeGinia in view of U.S. Patent No. 6,107,258 to Esche; the rejection of claims 9-18 under 35 U.S.C. 103(a) over DeGonia and Esche further in view of U.S. Patent No. 6,133,210 to Tipton; the rejection of claims 41-47 under 35 U.S.C. 103(a) over DeGonia in view of Esche in further view of U.S. Patent No. 5,888,947 to Lambert; the rejection of claims 8 and 33-40 under 35 U.S.C. 103(a) over DeGonia in view of Esche and Lambert further in view of U.S. Patent No. 6,427,647 to Galka; the rejection of claim 55 under 35 U.S.C. 103(a) over DeGonia in view of Esche further in view of U.S. PG Pub. No. 2002/1471116A1; and the rejection of claim 56 under 35 U.S.C. 103(a) over DeGonia in view of Esche further in view of Graham.

Applicants submit that the rejections are in their essence rooted in hindsight and "invitation (obvious) to try," neither of which satisfy the statutory criteria of 35 U.S.C. 103(a). Graham v. John Deere, 383 U.S. 1 (1966). Applicants respectfully solicit favorable reconsideration. This is aptly illustrated by the rejections themselves

where the Office Action concedes the primary reference(s) do not describe or teach a particular claimed feature, and then the missing feature is isolated from another 'prior art' reference, and then combined to find obviousness. That's hindsight.

Applicants' traversal is illustrated by the subject matter defined by claims 1-7, 19-32, 48 and 57. For instance, claim 1 recites "an amination product of a hydrocarbyl substituted succinic acylating agent and a mixture comprising an aliphatic polyamine and an aromatic polyamine," and that mixture does not appear to be described or suggested by the DeGonia patent or the Esche patent. Claim 1 also recites that "the molar ratio of aliphatic polyamine to aromatic polyamine in the mixture ranges from about 10:0.1 to about 0.1:10, and wherein the amination product contains at least about 0.1 molar equivalent of the polyamine mixture to 1 molar equivalent of the hydrocarbyl substituted succinic acylating agent." Again, neither the DeGonia nor the Esche patents appear to describe or suggest the "molar ratio" and that the "amidation product contains at least about 0.1 molar equivalent of the polyamine mixture to 1 molar equivalent of the hydrocarbyl substituted succinic acylating agent." Since neither reference describes and neither suggests the elements of claim 1, Applicants respectfully solicit favorable reconsideration.

Applicants courteously solicit reconsideration as to claims 6, 24 and 31. Here, the Office Action at page 4 acknowledges that "DeGonia does not teach the specific aromatic polyamines recited in Claims 6, 24 and 31, nor does DeGonia give motivation for specifically using aromatic polyamines along with aliphatic polyamines in the amine mixture."

Yet, the Office Action refers to Esche's claim 7 as the basis for asserting it would have been obvious to include the subject matter of Esche's claim 7 into DeGonia. Applicants earnestly submit the Office Action errs inasmuch as Esche's

claim 7 defines the scope of an embodiment in Esche's invention, which is not necessarily the same as description. Indeed, a similar rejection was reversed by the Federal Circuit. In re Benno, 226 U.S.P.Q. (BNA) 683 (Fed. Cir. 1985):

Samuel F. B. Morse, the inventor of the telegraph, had a patent thereon, issued in 1840, containing a claim (which the Supreme Court held invalid) which was broad enough to read on the modern Telex. See O'Reilly v. Morse, 56 U.S. 62, 112 (1853). By the board's reasoning, Morse's telegraph patent therefore would have made the Telex obvious. The scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses. A patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding. While it is true, as the Solicitor suggested at oral argument, that "a claim is part of the disclosure," that point is of significance principally in the situation where a patent application as filed contains a claim which specifically discloses something not disclosed in the descriptive part of the specification (claims being technically part of the "specification," 35 USC 112, 2d par.), in which case the applicant may amend the specification without being charged with adding "new matter," within the meaning of §132. See 37 CFR 1.118. ("All amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of filing the application." (Emphasis ours.)) But that is not the situation here. Danti's claim 1 does not disclose any structure additional to what the Danti specification discloses.

For the above reasons, we hold that the board erred in relying on Danti's claim 1 in deciding that appellant's claims would have been obvious from that reference alone and also in reaching that conclusion.

Here, Esche's relevance hinges on the specific focus on the claim 7, but that claimed invention does not support the reasoning advanced in the Office Action, page 4. Indeed, combining reference because both are in the fuels field or both are in the lubricant arts is not appropriate under 35 U.S.C. 103(a), whether it's under Graham v. John Deere or whether it's under the Federal Circuit rulings, such as the more recent Dystar case. At its best, the Office Action presents an obvious to try scenario, which is insufficient.

Similarly, Applicants courteously solicit reconsideration of the rejection of claims 9-18 over DeGonia and Esche plus Tipton. The primary references would not have been combined – as discussed above, and even if combined they do “not disclose the method of reacting the components recited in claim 9.” Office Action, page 5. Tipton merely discloses some attributes that gain relevancy only by looking at Applicant's claims, finding the missing teachings, and applying Tipton for the missing teachings. Again, this seems well-grounded in hindsight.


Applicants submit the remaining rejections are amenable to favorable reconsideration in view of the remarks herein. Such favorable reconsideration is courteously solicited.

The rejections of claims 55-57 are mooted without prejudice to replacing such claims in this or a continuation application.

For the foregoing reasons, the applicant request that claims 1-54 and 58-63 be allowed to pass to issue.

Respectfully submitted,

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